

REMARKS

In the Office Action mailed October 17, 2007¹, the Examiner rejected claims 1-20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,673,691 to Abrams et al. ("Abrams") in view of U.S. Patent No. 6,013,007 to Root et al ("Root").

By this Amendment, Applicants have amended claims 1, 19, and 20. Claims 1-20 are currently pending.

I. The Rejection of Claims 1-20 under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 1-20 under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *id.* "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." M.P.E.P. § 2145. Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, "[i]n determining the differences between the prior

¹ As Applicants' remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicants' silence as to certain requirements applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references) is not a concession by Applicants that such requirements have been met, and Applicants reserve the right to analyze and dispute such in the future.

art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

“[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III). In this application, a *prima facie* case of obviousness has not been established because the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the Office Action has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

Independent claim 1 recites an apparatus for supporting a user's behavior, comprising, among other things, a “behavior schedule reorganization unit configured to reorganize the user schedule by referring to the behavior rule, wherein at least the route schedule is reorganized, an exercise being inserted into a time segment of the reorganized route schedule” (emphasis added).

Abrams discloses a computer that prepares and monitors a weight, nutrition, and exercise program, including prompts that inform a user when to eat and exercise (*Abrams*, abstract). The exercises that *Abrams* suggests include walking, swimming, and cycling (*Abrams*, col. 6, lines 1-3). However, *Abrams* does not suggest the user walk, swim, or cycle according to a “route schedule,” but rather leaves it up to the user to walk, swim, or cycle according to any route that meets the exercise goals. Indeed, the Examiner concedes that *Abrams* does not disclose running or walking a route (Office Action at p. 3). Therefore, *Abrams* does not teach or suggest a “behavior schedule reorganization unit configured to reorganize the user schedule by referring to the behavior rule, wherein at least the route schedule is reorganized, an exercise being inserted into a time segment of the reorganized route schedule” (emphasis added), as recited by independent claim 1.

Root fails to cure the deficiencies of *Abrams*. *Root* discloses a personal athletic performance monitor that gives an athlete performance feedback data such as elapsed exercise time, distance covered, pace, elevation, and distance to go to reach a pre-set target (*Root*, abstract). *Root* also discloses that the monitor includes a GPS receiver module that continuously determines the athlete's position (*Root*, col. 7, lines 41-50), and that the athlete can download pre-determined courses from a computer (*Root*, col. 8, lines 1-4).

The Office Action characterizes *Root* by stating that “a user exercises by running a preset course (route) and feedback is provided to help the user meet preset exercise targets” (emphasis added) (Office Action at p. 4). Even assuming this characterization

is correct, any feedback to the user is for exercise already accomplished, and not part of any kind of schedule. Moreover, while *Root* does disclose presenting the user with a “distance to go,” the distance to go is not “inserted” into any kind of schedule for the user.

Root also discloses email messages between runners in order to schedule a “future exercise session” (*Root*, col. 9, lines 52-62). However, these emails are sent by the users directly to one another, and are not implemented by a “behavior schedule reorganization unit.” Further, *Root* does not suggest the “future exercise session” is inserted into a route schedule for a user. Therefore, *Root* does not teach or suggest a “behavior schedule reorganization unit configured to reorganize the user schedule by referring to the behavior rule, wherein at least the route schedule is reorganized, an exercise being inserted into a time segment of the reorganized route schedule,” as recited by independent claim 1 (emphasis added).

Applicants further note that the claimed “behavior schedule reorganization unit” reorganizes the user schedule comprising the route schedule by “referring to [a] behavior rule,” and the behavior rule represents “a tendency of the user’s behavior in the past.” However, nothing in *Abrams* or *Root* teaches or suggests reorganizing a route schedule with reference to a rule representing a tendency of a user’s past behavior. For at least this additional reason, *Abrams* and *Root* both fail to teach or suggest the claimed behavior schedule reorganization unit.

In view of the mischaracterizations of the references discussed above, the Examiner has neither properly determined the scope and content of the prior art nor

properly ascertained the differences between the prior art and the claimed invention.

Accordingly, the Examiner has failed to clearly articulate a reason why independent claim 1 would have been obvious to one of ordinary skill in view of the art. Therefore, a *prima facie* case of obviousness has not been established and the Examiner should withdraw the rejection of independent claim 1 under 35 U.S.C. § 103(a).

Independent claims 19 and 20, although of different scope from claim 1 and from each other, recite elements similar to those discussed above with respect to claim 1. Accordingly, for at least the reasons discussed above with respect to claim 1, no *prima facie* case of obviousness has been established for claims 19 and 20. Therefore, the Examiner should withdraw the rejection of claims 19 and 20 under 35 U.S.C. § 103(a).

Claims 2-18 depend from claim 1 and therefore include all the elements recited therein. Accordingly, no *prima facie* case has been established with respect to claims 2-18 at least due to their dependence. Therefore, Applicant respectfully requests the Examiner to withdraw the rejection of claims 2-18 under 35 U.S.C. § 103(a).

II. Conclusion

In view of the foregoing, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

If there is any fee due in connection with the filing of this Reply, please charge
the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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